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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,059	02/14/2000	MARIA RAIDEL	KCC-13368.10	5484

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EXAMINER

WEBB, JAMISUE A

ART UNIT PAPER NUMBER

3761

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/402,059

Examiner

Jamisue A. Webb

Applicant(s)

RAIDEL ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 11/21/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the reference submitted with the IDS has not identifying marks of any kind, therefore the examiner cannot know for sure if this is reference TW A 286,541 that is listed on the IDS. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Response to Amendment

2. The amendments filed 1/28/02 and 12/17/02 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the phrase "after absorbing at least about 10.5 grams water per gram flowable absorbent material" and the term "nonswellable".

3. With regards to the phrase "after absorbing at least about 10.5 grams water per gram flowable absorbent material": in the specification, on page 15, it states that polymethylene urea remains able to flow up to a water absorption of 10.5 g/g, and that any amount over that the material starts to become lumpy and starts to gel. By saying in the claim that the material

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remains able to flow after absorbing at least 10.5 g/g means that anything thing over 10.5 g/g the material still remains able to flow, and this is clearly not what is stated in the specification. The specification also gives other examples but states that there is slight expansion and gel blocking occurring. Furthermore, the claim uses the word "about" 10.5 g/g, and in the specification it states at 10.5 g/g, therefore the word "about" is new matter.

4. With regards to the phrase "nonswellable": the specification on page 14 and 15, and on Table 1, states examples where the maximum water absorption capacity is where no volume increase was possible, and expansion was prevented. This does not mean the material itself was swellable, it means that it prevented. Furthermore, the maximum water absorption capacity seems to be the maximum of water that can be absorbed before the material swells, however if this is the case, then it implies that if the examples given absorbed a greater amount than what is given in the table (maximum water absorption capacity), then they would swell, and therefore the material itself is not nonswellable.

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

5. The specification is objected to as containing subject matter, which was not described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe how to make a an absorbent material that is nonswellable and remains able to flow able to flow after absorbing at least about 10.5 grams water per gram flowable material. The specification states that polymethylene urea remains able to flow up to a water absorption of 10.5 g/g, and that any

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amount over that the material starts to become lumpy and starts to gel, which would cause it to swell and not be able to flow. By saying in the claim that the material remains able to flow after absorbing at least 10.5 g/g means that anything thing over 10.5 g/g the material still remains able to flow, and this is clearly not what is stated in the specification. The specification also gives other examples but states that there is slight expansion and gel blocking occurring. Therefore one of ordinary skill in the art would not be able to look at the specification and determine how to make an absorbent material that is nonswellable and remains able to flow after absorbing at least about 10.5 grams water per gram of flowable absorbent material

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 45-111 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As well as was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See above for description of new matter added to the claims as well as description of enablement.

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8. It should be noted, that due to the new matter and enablement issues described above, a lack of prior art rejection does not indicate that the claim is allowable.

Response to Arguments

9. After further consideration of the limitations added to the claims in the present amendment as well as the previously submitted amendment, the examiner now considers the added limitations as new matter, as described above. During the interview, the applicant's representative explained the maximum water absorption capacity as the amount of water absorbed before the material expands, or swells. However after reading over the specification on the description of the test it states that expansion was prevented, therefore the material was not allowed to swell, not that it is nonswellable. The arguments state that the examiner agreed that the prior art of record does not disclose a nonswellable absorbent material which is capable of absorbing at least about 10.5 times its own weight in water under conditions where no volume expansion is possible, however the examiner did not agree to this. The examiner agreed that the prior art of record "appeared" to swell when absorbing fluids, and therefore did not meet the limitation of nonswellable, however the limitation of "under conditions where no volume expansion was possible" was not discussed. Furthermore, after further consideration of the "at least about 10.5 grams..." the examiner considers this to mean that the material must remain able to flow after it absorbs more than 10.5 g/g, which the specification clearly teaches otherwise (noted above). Therefore after further consideration of the claims, the examiner now considers these two limitations new matter, which would render the specification nonenabled.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579.

The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jaw 
February 24, 2003


WEILUN LO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700